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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,975	07/25/2001	Suellen Kae Birkholz	ROC920010108US1	6558

7590 06/17/2004

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EXAMINER
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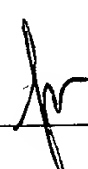
NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/912,975	<b>Applicant(s)</b> BIRKHOLZ ET AL.	
	<b>Examiner</b> Hoang-Vu A Nguyen-Ba	<b>Art Unit</b> 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/16/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the application filed July 25, 2001.
2. Claims 1-26 have been examined.

### *Claim Objections*

3. Claims 2, 3 and 18-20 are objected to because of the following informalities:
  - a. in claims 2 and 3, the comma “,” after “further comprising” should be replaced with a colon – : –
  - b. in claims 18-20, the verb “comprises” should be changed to – comprise – to agree with the subject “the steps.”

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 18, 19 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18, 19 and 20 recite the limitation “the steps further comprises” at line 1. There is insufficient antecedent basis for this limitation in the claim. The limitation “the steps further comprises” should be changed to – the steps of upgrading further comprise – to give the limitation proper antecedent basis.

*Claim Rejections – 35 U.S.C. § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 and 14-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,845,077 to Fawcett.

**Claims 1, 14 and 17**

Fawcett disclose at least:

*receiving, by a supplier system, a software inventory from the customer system (see at least Figure 4A, step 70 and related discussion in the specification);*

*verifying one or more business contracts for the software inventory utilizing one or more databases connected to the supplier system (see at least Figure 4A, step 72 and related discussion in the specification);*

*determining one or more software upgrade releases for the software inventory utilizing a product topology database connected to the supplier system (see at least Figure 4A, steps 74, 76, 78, 80, 82 and related discussion in the specification).*

**Claims 2 and 18**

The rejection of base claim 1 is incorporated. Fawcett further discloses *displaying the one or more software upgrade releases for customer approval (see at least Figure 4B, step 82 and related discussion in the specification).*

### Claims 3 and 19

The rejection of base claims 1 and 17 and intervening claims 2 and 18, respectively is incorporated. Fawcett further discloses *forwarding an approved order to a fulfillment and distribution center* (see at least Figure 4B, steps 86, 88, 90, 92 and related discussion in the specification).

### Claims 4 and 20

The rejection of base claims 1 and 17 and intervening claims 2 and 18, respectively is incorporated. Fawcett further discloses *prompting one or more responses from a customer utilizing graphical user interfaces* (see at least Figure 4B, steps 90, 92 and related discussion in the specification).

### Claim 5

The rejection of base claim 1 is incorporated. Fawcett further discloses *wherein the software inventory is received after a software upgrade request* (see at least Figure 4A, step 68, 70 and related discussion in the specification).

### Claim 6

The rejection of base claim 1 is incorporated. Fawcett further discloses *wherein the software inventory is received periodically* (see at least Abstract, lines 3-4 and related discussion elsewhere in the specification).

### Claims 7 and 21

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein verifying one or more business contracts comprises validating subscription for one or more*

*subscription software in the software inventory utilizing a subscription entitlement database (see at least 2:61 – 3:2).*

### **Claims 8 and 23**

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein verifying one or more business contracts comprises verifying entitlement for one or more keyed software in the software inventory utilizing a keyed management system database (see at least 2:58 – 3:2, e.g., “encryption scheme,” “secure transaction technology,” “digital signature”).*

### **Claims 9 and 23**

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases comprises mapping software releases in the software inventory to software upgrade releases (see at least 2:30 – 45).*

### **Claims 10 and 24**

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases comprises: filtering the software inventory; categorizing the software inventory; mapping software releases in the software inventory, to software upgrade releases; categorize software upgrade releases; and generate an upgrade order (see at least Figure 4A, steps 72, 74, 76; Figure 4B, steps 78, 80, 82, 86 and related discussion in the specification).*

### **Claims 11 and 25**

The rejection of base claims 1 and 17 and intervening claims 10 and 24, respectively is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases further comprises: cross-referencing release-to-release product configurations*

*for the software upgrade releases* (see at least Figure 4A, steps 72, 74, 76 and related discussion in the specification).

#### **Claim 15**

The rejection of base claim 14 is incorporated. Fawcett further discloses *wherein the supplier system comprises a software upgrade system having a software upgrade server connected to an interface server* (see at least Figure 2, items 40 and 46 respectively and related discussion in the specification).

#### **Claim 16**

The rejection of base claim 14 and intervening claim 15 is incorporated. Fawcett further discloses *wherein the supplier system further comprises a security mechanism connected to the software upgrade system, the security mechanism having connections to a network* (see at least 10:15-25).

### ***Claim Rejections – 35 USC § 103***

8. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett, as applied to base and intervening claims 1, 10 and 17, 24 respectively in

view of U.S. Patent Application Publication No. U.S. 2002/0129356 to Hellerstein et al. ("Hellerstein").

### **Claims 12 and 26**

The rejection of base claims 1 and 17 and intervening claims 10 and 24, respectively is incorporated. Fawcett does not specifically disclose *wherein determining one or more software upgrade releases further comprises: verifying pre-requisite and co-requisite software for the software upgrade releases*. However, Hellerstein discloses component dependency checking (see at least Figure 4 and related discussion in the specification) for the purpose of ensuring a trouble-free software upgrade automating. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hellerstein's feature to Fawcett for the purpose discussed above.

### **Claim 13**

The rejection of base claim 1 is incorporated. Fawcett does not specifically disclose *receiving an order for additional software; and verifying pre-requisite and co-requisite software for the additional software*. However, Hellerstein discloses component dependency checking (see at least Figure 4 and related discussion in the specification) for the purpose of ensuring a trouble-free software upgrade automating. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hellerstein's feature to Fawcett for the purpose discussed above.



*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number

(703) 872-9306

A handwritten signature in cursive script that reads "Antony Nguyen-Ba".

**ANTONY NGUYEN-BA  
PRIMARY EXAMINER**

Art Unit 2122

June 8, 2004